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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,104	08/22/2001	Natalie Bryant	3245/FBR	9322
26304	7590	09/23/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN			JONES, SCOTT E	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
			3713	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/935,104	<b>Applicant(s)</b> BRYANT, NATALIE	
	<b>Examiner</b> Scott E. Jones	<b>Art Unit</b> 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment and request for continued examination filed on June 9, 2004 in which applicant amends claim 1, adds new claims 6-8, and responds to the claim rejections. Claims 1-8 are pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 9, 2004 has been entered.

### ***Claim Objections***

3. Claims 1-8 are objected to under 37 C.F.R. 1.75 because each claim lacks a proper preamble and each claim element should be separated by a line indentation in each of claims 1, 6, and 8.

Correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slot Machines  
A Pictorial Review - 1973 Bally "Circus".

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Slot Machines A Pictorial Review - 1973 Bally "Circus" discloses a mechanical reel slot machine having a circus theme. Slot Machines A Pictorial Review - 1973 Bally "Circus" additionally discloses:

Regarding Claims 1, 6, and 8:

- the display means displays a plurality of spinning reels (See Figure),
- each reel carrying symbols from a set of symbols (See Figure),
- one of the symbols (monkey symbol) of the set of symbols on the reels of a gaming machine is a scatter symbol (See Figure and p. 119),
- in respect to at least one of the reels, the set comprising a plurality of the scatter symbols (monkey symbols), at least certain of the scatter symbols on said at least one reel being separated from each other on the reel by at most one symbol, so that when more than a minimum number of scatter symbols are displayed simultaneously at any one time when the reels are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols (See Figure and p. 119).

Although Slot Machines A Pictorial Review - 1973 Bally "Circus" discloses "an unusual play feature...the monkey special (scatter pay), which pays 20 coins for three monkeys in any position in the reel glass.", Slot Machines A Pictorial Review - 1973 Bally "Circus" possibly lacks explicitly disclosing:

Regarding Claims 1, 6, and 8:

- in respect to at least one of the reels, the set comprising a plurality of the scatter symbols (monkey symbols), at least certain of the scatter symbols on said at least

on reel being separated from each other on the reel by no more than one symbol position, so that when more than one scatter symbols of the at least one reel is displayed simultaneously with scatter symbols occurring on any of the other reels at any one time when the reels are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols.

Regarding Claim 2:

- the display means is a video display unit and the display of the reels is constituted by a video simulation.

Regarding Claim 3:

- the set of symbols on each of the reels has more than one occurrence of the scatter symbol.

Regarding Claim 4:

- the set of symbols of each reel has at least two scatter symbols.

Regarding Claim 5:

- the scatter symbols are positioned on each reel such that up to three scatter symbols are able to be displayed at any one time.

Regarding Claims 7 and 8:

- there are more special symbols able to be displayed than there are reels constituting the spinning reel game.

Regarding claim 2, to one having ordinary skill in the art at the time of Applicant's invention, having a display means to simulate spinning reels in a slot machine was notoriously well known. It would have been obvious to replace the display shown in Slot Machines A

Pictorial Review - 1973 Bally "Circus" with a video display that simulates spinning reels. One would be motivated to do so in order to reduce the amount of time required to "spin" the reels. Reduced reel spin times equate to higher play rates and increased profits for casino operators.

Regarding claims 1, 3, 4, 5, 6, 7, and 8, it would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate more than one scatter symbol on at least one reel in a gaming machine, such as the gaming machine disclosed in Slot Machines A Pictorial Review - 1973 Bally "Circus". One would be motivated to do so because adding additional scatter symbols to a reel strip increases the probability that a player will obtain scatter symbols and hence an award for a scatter symbol combination making the gaming machine highly desirable to players.

#### ***Response to Arguments***

6. Applicant's arguments and amendment with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's reply alleged that Slot Machines A Pictorial Review - 1973 Bally "Circus" does not disclose a scatter pay type gaming machine. The examiner respectfully disagrees with Applicant's allegation. Clearly, Slot Machines A Pictorial Review - 1973 Bally "Circus" discloses a scatter pay type gaming machine. Slot Machines A Pictorial Review - 1973 Bally "Circus" discloses "an unusual play feature...the monkey special, which pays 20 coins for three monkeys in any position in the reel glass." Furthermore, Slot Machines A Pictorial Review - 1973 Bally "Circus" scatter pay does not require that the monkey scatter pay symbols be on any one particular payline. However, in light of the remainder of Applicant's response and amendment to claim 1, a new ground of rejection is provided above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (703) 308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones  
Examiner  
Art Unit 3713



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